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PATENT

Customer No. 22,852

Attorney Docket No. 1165-799

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Chisa Hayakawa et al.

Application No.: 09/674,152

Filed: October 27, 2000

For: Composite Cloth

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Group Art Unit: 1771

Examiner: Jeremy R. Pierce

Handwritten signature and initials.

Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION

In the Office Action of February 13, 2003, the Examiner finally rejected, inter alia, claim 9 for being obvious over Hayakawa; claims 3 and 7-9 for being obvious over Moretz et al. in view of Mouri et al.; and claim 10 for being obvious over Moretz et al. and Mouri et al. further in view of Unitika. These are all new grounds of rejection relative to the first Office Action of June 19, 2002. Further, Moretz et al., Mouri et al., and Unitika were cited for the first time in the Office Action of February 13, 2003.

M.P.E.P. §706.07(a) clearly provides as follows:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement Furthermore, a second or any subsequent action on the merits in any application . . . will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement . . . of any claim not amended by applicant or

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patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP. § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

As noted on page 3 of the Amendment filed December 19, 2002 and as clearly seen from the amended version of main claim 3 in the Appendix thereto, claim 3 was merely "rewritten in independent form and claims 7-10 amended to depend solely from claim 3." Minor amendments were made to claim 3 in rewriting it in independent form for clarity, but none of these were made in view of any cited prior art or changed the scope of the claim. Accordingly, it is submitted that the new grounds of rejection were **not** necessitated by applicants' amendment of the claims and should be withdrawn. Applicants should be entitled to an opportunity to fully respond to the Office Action of February 13, 2003 and the newly cited references without being restricted by the requirements of Rule 116.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 17, 2003

By: 

Arthur S. Garrett
Reg. No. 20,338

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